

Notice of Allowability

Application No.

10/715,305

Examiner

Daniel J. Colilla

Applicant(s)

MARSHALL, MARTEN DWIGHT

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to the interview held on 2/8/06.
2. ☒ The allowed claim(s) is/are 37 and 39-43.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

EXAMINER'S AMENDMENT

1. This application is in condition for allowance except for the presence of claims 8-36 to an invention non-elected without traverse. Accordingly, claims 8-36 been cancelled.

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Marten Marshall on 2/8/06.

The application has been amended as follows:

In claim 37, lines 3-4, "the objects" has been replaced with --a first object from the first single sided picture and a second object from the second single sided picture--.

The above change has been made to provide proper antecedent basis for the terms "the objects," "first object" and "second object" in the claims.

In claim 37, the last line, "said" has been replaced with --each respective--.

The above change has been made to remove the term, "said object" which was ambiguous since it was not clear to which particular object was being recited.

Claim 38 has been cancelled.

The above change has been made to remove a claim of improper form. This claim has been replaced by the new claims listed below.

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In claim 39, line 2, "consists of" has been replaced with --comprising--.

In claim 40, line 2, "consists of" has been replaced with --comprising--.

The above changes have been made to replace the closed terminology "consisting of" with the open terminology, --comprising--, thus broadening the scope of the claim to the advantage of applicant. Regarding this change, see MPEP 2111.03 [R-3]:

2111.03 [R-3] Transitional Phrases

The transitional phrases "**comprising**", "consisting essentially of" and "consisting of" define the scope of a claim with respect to what unrecited additional components or steps, if any, are excluded from the scope of the claim. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. . .

. . . The transitional phrase "**consisting of**" excludes any element, step, or ingredient not specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("consisting of" defined as "closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith."). But see Norian Corp. v. Stryker Corp., 363 F.3d 1321, 1331-32, 70 USPQ2d 1508, 1516 (Fed. Cir. 2004). . .

The following new claims have been added:

--Claim 41. A method for creating one 2-sided picture from a first single sided picture

and a second single sided picture, comprising the steps of:

- a. removing the backgrounds from both said single sided pictures leaving just a first object from the first single sided picture and a second object from the second single sided picture to be printed, and
- b. modifying the shapes of one or both said objects, that have had said backgrounds removed, in order to make said objects congruent, such that said shape modifications result in minimal distortion of the images, and
- c. printing said first object onto a transparent medium, and

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d. printing said second object over said first object such that said second object completely covers said first object but does not extend beyond the edges of said first object, whereby the resultant 2-sided image shows each respective object from 2 opposite sides.

Claim 42. The method of claim 41 further stipulating that said transparent medium comprises decal material.

Claim 43. The method of claim 41 further stipulating that said transparent medium comprises a transparent rigid material suitable for physically cutting.--

The above claims have been added to provide claim protection intended by applicant in the previous version of the claims but was not properly recited in that previous version.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 10, 2006



Daniel J. Colilla
Primary Examiner
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